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REMARKS

Claims 1-97 are in this application Claims 88-97 have been added and these are based on the previous version of claims 48, 60, 65, 70, 80 and 62, respectively. Claim 1 has been amended to include a definition of R. Support for this definition of R is found on page 7 of the specification. Therefore, it is respectfully requested that the rejection under 35 USC 112, second paragraph be withdrawn.

According to the action, claims 1-22 are rejected as being obvious over Watanabe et al. This is respectfully traversed.

Watanabe teaches preparation of only 1,2-propanediol and not a mixture of 1,2-propanediol and 1,3 propanediol as claimed in claims 1-22. As discussed on page 3 of the specification and as noted by the examiner, Watanabe only obtained 2-acetoxypromanal with rhodium catalyst and the hydrogenation and hydrolysis is carried out with hazardous reagents.

As stated in MPEP 2141, citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n. 5 (Fed. Cir. 1986), when applying 35 USC 103, the following tenets of patent law must be adhered to:

- 1) the claimed invention must be considered as a whole;
- 2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; and
- 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Reasonable expectation of success is the standard with which obviousness is determined.

In re Merck & Co., Inc., 800 F.2d109, 231 USPQ 375 (Fed. Cir. 1986).

Considering the claimed invention as a whole there is no teaching nor suggestion in Watanabe of a process according to claims 1-22 that can be used to prepare both 1,2 and 1,3 propanediol so it respectfully requested that the rejection be withdrawn.

The Examiner has also rejected claims 23-87 as being obvious over the combination of Watanabe and US patent 5,530,150. This is respectfully traversed.

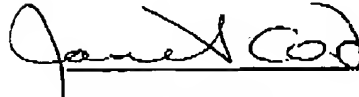
For the reasons explained above, Watanabe does not make the claimed invention obvious. The addition of US patent 5,530,150 does not overcome the deficiency.

There is no suggestion in the combination of references that would lead to the claimed invention. In fact, there is no suggestion to combine the '150 patent with Watanabe. Watanabe teaches preparation of asymmetric 1,2- propanediol and therefore, one skilled in the art would not consider both of these references to obtain a process to produce 1,2- and 1,3- propanediols. Further Takaya teaches the use of benzene during hydroformylation and the phosphine catalyst precursor of Takaya is different from the instant invention. There is no suggestion nor motivation to replace the catalyst of Watanabe with the catalyst of Takaya to obtain 1,2 and 1,3 propanediols in the yields and selectivities claimed in this application.

Accordingly, it is respectfully requested that the rejection be withdrawn.

It is submitted that the present application is in condition for allowance and favorable consideration is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Janet I. Cord". The signature is fluid and cursive, with the first name "Janet" and last name "Cord" clearly distinguishable.

JANET I. CORD

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